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OFFICE OF PETITIONS

In re Application of :
CHIRICA et al. : DECISION ON APPLICATION
Application No. 10/667,289 : FOR PATENT TERM ADJUSTMENT
Filed: September 18, 2003 :
Attorney Docket No. DX01074B :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705(b))" filed June 6, 2008. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from 482 days to 651 days.

The application for patent term adjustment is DISMISSED.

On March 11, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 482 days. On June 6, 2008, applicants timely submitted the instant application for patent term adjustment¹. Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

Applicants dispute the period of adjustment of 543 days entered pursuant to 37 CFR 1.702(a)(1) and 1.703(a)(1) for Office delay in failing to mail the first Office action under 35 U.S.C. 132 no later than 14 months after the actual filing date of the application. Applicants assert that 543 days of patent term

¹ The Office records show that the issue fee was also received on June 9, 2008.

adjustment under 37 CFR 1.702(a)(1) and 1.703(a)(1) is in error because the Office failed to appreciate that the Restriction Requirement mailed on May 15, 2006, was withdrawn by the nonfinal Office action of October 31, 2006. Applicants contend that the Restriction Requirement should more properly have been vacated and that the October 31, 2006 mailing date of the nonfinal Office action should have been used to calculate the period of adjustment pursuant to 37 CFR 1.702(a)(1) and 1.703(a)(1).¹

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 154(b)(1)(A)(i) provides that:

– Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to–

(i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after–

(I) the date on which an application was filed under section 111(a) of this title; or

(II) the date on which an international application fulfilled the requirements of section 371 of this title[.]

37 CFR 1.702 provides that:

(a) Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

¹ Applicants state in footnote one of the instant application for patent term adjustment that this identical issue was raised in a sister application, No. 10/667,290, in which the Examiner indicated in a second Restriction Requirement that the original Restriction Requirement was vacated. However, the Office notes that the proper procedure for when an error in an Office action is brought to the attention of the Office is for the Examiner to withdraw the previous Office action, mail a corrected or supplemental Office action, and set an appropriate period for reply.

(1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application[.]

37 CFR 1.703 provides, in pertinent part, that:

(a) The period of adjustment under § 1.702(a) is the sum of the following periods:

(1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first[.]

OPINION

Applicants' arguments and evidence have been considered. In light of the application history, it has been determined that the period of adjustment of 543 days for Office delay pursuant to 37 CFR 1.702(a)(1) is correct. It is undisputed that the Office mailed an action under 35 U.S.C. 132 in the form of a Restriction Requirement on May 15, 2006, fourteen months and 543 days after the actual filing date of this application. On August 15, 2006, applicants filed a response within three months of the mailing date of the Restriction Requirement. On October 31, 2006, the Office mailed a nonfinal Office action, which states in pertinent part:

[] Applicant's request for the withdrawal of the restriction requirement filed 8/15/2006 is acknowledged. Applicant requests the withdrawal based on the preliminary amendments filed 9/18/2003. Therefore, Office will withdraw the restriction requirement of 5/15/2006. Claims 24-31 are pending and are examined.

Nonfinal Office action dated 10/31/06, p. 2.

The subsequent mailing of another Office action under 35 U.S.C. 132 does not alter the date used in calculation of the period of adjustment. Pursuant to 35 U.S.C. 154(b)(1)(A), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after the first 14 months of pendency of the application before the Office, to the extent that the Office failed to make an objection or argument under 35 U.S.C. 132 until May 15, 2006. The fact that the Office later withdrew the Restriction Requirement does not negate the fact that the Office took action within the meaning of 37 CFR 1.702(a)(1) on May 15, 2006. Thus, it is correct for the Office to use the date of May 15, 2006, in calculating the period of adjustment due to the examination delay in initially acting on this application. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000). Accordingly, the period of adjustment of 543 days is correct and will not be changed.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance remains 482 days.

The \$200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent.

The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent.

Telephone inquiries specific to this matter should be directed to Christina Tartera Donnell, Senior Petitions Attorney, at (571) 272-3211.



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